

REMARKS

Reconsideration and allowance of the above-identified application are respectfully requested. Claims 1-16 remain pending, wherein claims 1, 2, 4, 7, 8, 11, 13, 14 and 16 have been amended.

Initially, Applicants note with appreciation the Examiner's consideration of the documents cited in the Information Disclosure Statement filed on September 7, 2001.

Applicants note that the Office Action Summary does not indicate acknowledgment of Applicants' claim for foreign priority and that the certified copies of the priority documents have been received. Applicants note that the certified copy of the priority document was filed on September 7, 2001. Accordingly, Applicants respectfully request that the next Office Action contain an acknowledgment of Applicants' claim for foreign priority and that all certified copies of the priority documents have been received.

Moreover, Applicants note that the Office Action Summary does not indicate acknowledgment of Applicants' claim for domestic priority under 35 U.S.C. §119(e). Accordingly, Applicants respectfully request that the next Office Action acknowledge Applicants' claim for domestic priority under 35 U.S.C. §119(e).

In the first paragraph of the Office Action claims 11 and 16 are rejected under 35 U.S.C. §112, second paragraph as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. This ground of rejection is respectfully traversed.

The Office Action asserts that the phrase "general authorisation" which is recited in claims 11 and 16 is not clearly defined. It is respectfully submitted that in view of

Applicants' disclosure, one of ordinary skill in the art would have known what is meant by the phrase "general authorisation" as recited in Applicants' claims 11 and 16. Applicants' claims 11 and 16 recited allowing the recording "if a general authorisation for the recording has been received and stored in the device." The present Application, at least at page 11, lines 17 through 32 and Figure 4, describe that a telephone may be preprogrammed to allow or refuse recording. It is respectfully submitted that in view of this disclosure, one of ordinary skill in the art would understand what was meant by the phrase "a general authorisation" as being the pre-programmed allowance of recording. Nevertheless, in the interest of expediting prosecution, Applicants have amended claims 11 and 16 to delete the word "general" such that these claims now recite "if an authorisation for the recording has been received and stored in the device." It is respectfully submitted that this amendment addresses the concerns raised in the Office Action, and does not limit the scope of these claims for any purpose. Accordingly, withdrawal of this rejection is respectfully requested.

In the second paragraph of the Office Action claims 1, 2, 4, 6-8, 10, 11 and 13-16 are rejected under 35 U.S.C. §102(e) as allegedly being anticipated by U.S. Patent No. 6,434,143 to Donovan ("Donovan"). This ground of rejection is respectfully traversed.

Donovan does not render Applicants' claim 1 unpatentable because Donovan does not disclose all of the elements of Applicants' claim 1. Specifically, Donovan does not disclose a method of recording a telephone conversation comprising the step of "sending from said telecommunications device to said second telecommunications device a message

requesting authorisation for the recording of the telephone conversation" as recited in Applicants' claim 1.

Donovan is directed to an Internet Protocol telephony voice/video message deposit and retrieval system. Donovan recognizes that Session Initiation Protocols (SIP) are used in Internet Protocol, but have not been defined for interfacing with messaging systems. Accordingly, Donovan discloses the use of SIP for interfacing with messaging systems. Specifically, as discussed in column 3, lines 40-45 of Donovan, when the called party cannot be reached, the call is forwarded to an Integrated Messaging System (IMS) 25. Specifically, Donovan discloses that the Network Server (NS) 23 sends an SIP INVITE request to the IMS 25. The IMS 25 responds to the NS 23 by sending a 200 OK message. The NS 23 then confirms that it has received a final response by sending an ACK message to the IMS 25. Accordingly, Donovan discloses that the SIP protocol is employed for interfacing between the NS 23 and the IMS 25. Donovan does not disclose a method of recording a telephone conversation between first and second telecommunication devices which involves a message requesting authorisation for recording the telephone conversation. Hence, Donovan does not disclose the step of "sending from said first telecommunications device to said second telecommunications device a message requesting authorisation for the recording of the telephone conversation" as recited in Applicants' claim 1.

In the rejection of Applicants' claim 1 the Office Action asserts that the "SIP INVITE request" message of Donovan corresponds to the "message requesting authorisation" recited in Applicants' claim 1; that the "message deposit action" of Donovan

corresponds to the "recording" of Applicants' claim 1; and that the "depositing the message in a destination mailbox" of Donovan corresponds to the step of "performing said recording" of Applicants' claim 1. However, Donovan does not disclose that the SIP INVITE request is a message requesting authorisation of the recording of the telephone conversation between first and second telecommunications devices. Hence, Donovan does not disclose the step of "sending from said first telecommunications device to said second telecommunications device a message requesting authorisation for the recording of the telephone conversation" as recited in Applicants' claim 1. Moreover, Donovan does not disclose that the message deposit action of Donovan records a telephone conversation between first and second telecommunications devices. Hence, Donovan does not disclose the step of "performing said recording only if a responding message giving said authorisation is received and recognized by said first telecommunications device in response to said requesting message" as recited in Applicants' claim 1. Therefore, Donovan cannot anticipate Applicants' claim 1.

Claims 6 and 7 depend from claim 1, and are, therefore, not anticipated by Donovan for at least those reasons stated above with regard to Applicants' claim 1.

Claim 2 recites a method of prohibiting the recording of a telephone conversation between first and second telecommunications devices. The method includes the step of "sending from said first telecommunications device to said second telecommunications device a message requesting authorisation for the recording of the telephone conversation."

As discussed above with regard to Applicants' claim 1, Donovan does not disclose a

message requesting authorisation for the recording of the telephone conversation. Hence, Donovan cannot anticipate Applicants' claim 2.

Donovan does not anticipate Applicants' claim 4, because Donovan does not disclose all of the elements of Applicants' claim 4. For example, Donovan does not disclose the step of "sending a responding message giving authorisation from said second telecommunications device under control of a user of the second communications device" as recited in Applicants' claim 4.

By this amendment, Applicants have amended claim 4 into independent form by incorporating all of the elements of Applicants' claim 1 into claim 4. Accordingly, the amended claim 4 corresponds to the claim 4 which was rejected by the Office Action. In rejecting Applicants' claim 4, the Office Action asserts that the step of "sending a responding message" of Applicants' claim 4 is inherent in the disclosure of Donovan. Specifically, the Office Action asserts that it "is inherent that the called party must respond an 'off-hook' signal when answers the call. The 'off-hook signal' is the claimed 'message for giving authorisation.'" To reject the steps of Applicants' claim 1 (now explicitly present in Applicants' claim 4), the Office Action asserted that the recited messages were anticipated by the SIP message exchange disclosed by Donovan. Donovan discloses the use of the SIP message exchange between the NS 23 and the IMS 25 for depositing a message in the IMS 25. Accordingly, the SIP message exchange disclosed by Donovan does not include a called party going off-hook, since going off-hook would result in the depositing of a message in the IMS 25 of Donovan. Hence, the step of "sending a responding message" recited in Applicants' claim 4 cannot be anticipated by the alleged

inherent disclosure of a called party going off-hook, since this is inconsistent with the Office Action's interpretation of other elements recited in Applicants' claim 4. Therefore, Donovan does not anticipate Applicants' claim 4.

Claim 8 recites a telecommunication device which is adapted to send "a message requesting authorisation for the recording of telephone conversations performed with said other telecommunications device." Since Donovan does not disclose the recording of telephone conversations between telecommunications devices including the use of a message requesting authorisation for recording telephone conversations, Donovan cannot anticipate Applicants' claim 8.

Claims 10 and 11 depend from claim 8, and are, therefore, not anticipated by Donovan for at least those reasons stated above with regard to claim 8.

Claim 13 recites a telecommunication device which can be "programmed to respond automatically to a received message requesting authorisation for the recording of telephone conversations performed with another telecommunications device." Since Donovan does not disclose recording telephone conversations between telecommunications devices including the use of a message requesting authorisation for recording telephone conversations, Donovan cannot anticipate Applicants' claim 13.

Claim 14 recites an electronic accessory device connectable to a telecommunications device, wherein the electronic accessory device "instruct[s] a telecommunication device to which it is connected to send to another telecommunications device a message requesting authorisation for the recording of telephone conversations performed between two telecommunications devices." Since Donovan does not disclose recording telephone

conversations between telecommunications devices including the use of a message requesting authorisation for recording telephone conversations, Donovan cannot anticipate Applicants' claim 14.

Claims 15 and 16 depend from claim 14, and are, therefore, not anticipated by Donovan for at least those reasons stated above with regard to Applicants' claim 14.

For at least those reasons stated above it is respectfully requested that the rejection of claims 1, 2, 4, 6-8, 10, 11 and 13-16 as allegedly being anticipated by Donovan be withdrawn.

In the third paragraph of the Office Action claim 3 is rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Donovan in view of U.S. Patent No. 5,289,532 to Ishikawa et al. ("Ishikawa"). In the fourth paragraph of the Office Action claim 9 is rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Donovan in view of U.S. Patent No. 5,703,935 to Raissyan et al. ("Raissyan"). In the fifth paragraph of the Office Action claim 12 is rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Donovan in view of U.S. Patent No. 6,351,635 to Ohsuge ("Ohsuge"). These grounds of rejection are respectfully traversed.

Claims 3, 9 and 12 variously depend from claims 1 and 8. As discussed above, Donovan does not disclose all of the elements of Applicants' claims 1 and 8. Moreover, it is respectfully submitted that Donovan does not suggest such. It is respectfully submitted that Ishikawa, Raissyan, and Ohsuge each do not remedy the above-identified deficiencies of Donovan with respect to claims 1 and 8. Hence, claims 3, 9 and 12 which variously depend from claims 1 and 8, are therefore, patentably distinguishable over the combination

of Donovan and Ishikawa, Raissyan, or Ohsuge for at least those reasons stated above with regard to Applicants' claims 1 and 8.

For at least those reasons stated above, it is respectfully requested that the obviousness rejections of claims 3, 9 and 12 be withdrawn.

All outstanding objections and rejections having been addressed, it is respectfully submitted that the present application is in condition for allowance. Notice to this effect this earnestly solicited. If there are any questions regarding this response, or the application in general, the Examiner is encouraged to contact the undersigned at 703-838-6578.

Respectfully submitted,

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Attachment to Amendment dated January 24, 2003

Mark-up of Claims

1. (Twice Amended) A method of recording [information exchanged] a telephone conversation between first and second telecommunications devices, said recording being performed under control of said first telecommunications device, wherein the method comprises the steps of:

sending from said first telecommunications device to said second telecommunications device a message requesting authorisation for the recording of the telephone conversation, and

performing said recording only if a responding message giving said authorisation is received and recognized by said first telecommunications device in response to said requesting message.

2. (Twice Amended) A method of prohibiting the recording of [information exchanged] a telephone conversation between first and second telecommunications devices, said recording being performed under control of said first telecommunications device, wherein the method comprises the steps of:

sending from said first telecommunications device to said second telecommunications device a message requesting authorisation for the recording of the telephone conversation, and

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prohibiting said recording if a responding message giving said authorisation is not received and recognized by said first telecommunications device in response to said requesting message.

4. (Twice Amended) A method [according to claim 1] of recording information exchanged between first and second telecommunications devices, said recording being performed under control of said first telecommunications device, wherein the method comprises the [step] steps of:

sending from said first telecommunications device to said second telecommunications device a message requesting authorisation for the recording,

sending a responding message giving authorisation from said second telecommunications device under control of a user of the second communications device, and

performing said recording only if said responding message giving said authorisation is received and recognized by said first telecommunications device in response to said requesting message.

7. (Twice Amended) A method according to claim 1, wherein said [information] telephone conversation is further [exchanged] performed between said first telecommunications device and at least one additional telecommunications device, and that

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said recording is only performed if a responding message giving said authorisation is also received from said at least one additional telecommunications device.

8. (Twice Amended) A telecommunications device for [exchanging information] performing telephone conversations with other telecommunications devices, said telecommunications device being equipped to perform a recording of said [exchanged information] telephone conversations, wherein the telecommunications device can assume a mode in which it is adapted to:

send to another telecommunications device a message requesting authorisation for the recording of [information to be exchanged] telephone conversations performed with said other telecommunications device, and

perform said recording only if a responding message giving said authorisation is received in response to said requesting message.

11. (Twice Amended) A telecommunications device according to claim 8, wherein the telecommunications device is further adapted to allow said recording if [a general] an authorisation for the recording has been received and stored in the device.

~~13. (Twice Amended) A telecommunications device for [exchanging information] performing telephone conversations with other telecommunications devices, wherein the telecommunications device can be programmed to respond automatically to a received~~

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message requesting authorisation for the recording of [information to be exchanged]
telephone conversations performed with another telecommunications device.

14. (Twice Amended) An electronic accessory device connectable to a telecommunications device for [exchanging information] performing telephone conversations with other telecommunications devices, said electronic accessory device being equipped to perform a recording of said [exchanged information] telephone conversations, wherein the electronic accessory device can assume a mode in which it is further adapted to:

instruct a telecommunications device to which it is connected to send to another telecommunications device a message requesting authorisation for the recording of [information to be exchanged] telephone conversations performed between the two telecommunications devices, and

perform said recording only if a responding message giving said authorisation is received in response to said requesting message.

16. (Twice Amended) An electronic accessory device according to claim 14, wherein the electronic accessory device is further adapted to allow said recording if [a general] an authorisation for the recording has been received and stored in the device.